

Application No. 09/992,665

REMARKS

Claims 1-134 are presently pending.

The undersigned thanks the Examiner for the opportunity to discuss the Restriction Requirement on December 9, 2004. At that time, the Examiner agreed to have another interview regarding the Restriction Requirement after receipt of this present response. Please do not make the restriction requirement final until we have had the opportunity for further discussion.

The Examiner has provided a detailed sixty-seven page Restriction Requirement. At page 49, the claims 68-73, 75, 76, and 81 were assigned to Group 37, with "a non-small cell lung cancer condition" being specified. Group 37 was further divided into Groups (A)-(I), Groups (a)-(et), and Groups (I-XVII), with invention i being a further Group when (a)-(et) is drawn to complexed proteins. The Examiner asserted that these Groups are not an election of species, e.g., at page 45. Among these Groups, Group A is "wherein at least one of the transcription modulating factors perturbs chromatin structure to permit access of transcriptional components of the gene" (page 18 of the Restriction Requirement); Group (d) is "a single specific factor, or a specific combination of the 43 specific factors recited in claim 96 as they are specifically drawn to transcription modulating factors that perturb chromatin structure to permit access of transcriptional components to a gene" (page 20 of the Restriction Requirement); and Group V "wherein said at least one of the transcription modulating factor forms a coactivation complex with a single one of the 7 proteins specifically recited in claim 88, wherein said factor is a single specific factor, or a specific combination of the 43 specific factors recited in claim [96]".

To be fully responsive, the undersigned makes elections with traverse as follows: Group 37 (with a non-small cell lung cancer condition); Group A; Group (d) Hey/HRT (claim 96); Group V Hey/HRT (claim 96). Hey/HRT is not necessarily drawn to a complexed protein. No admission is made with respect to the scope of the claims or nature of the elected inventions.

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Claim 67 is a genus claim that links a variety of species, which are set forth in the dependent claims. Since claim 67 is generic for all claims 67-110, these cannot be separate inventions except in a genus/species sense. Claims 67-81 are generic with respect to transcription factors, claims 67, 70-81 are generic with respect to the sample taken from the patient, claims 67-69, 73-76 are generic with respect to the method of testing the sample, and claims 67-73, 77-81 are generic with respect to a cancer type.

The Restriction Requirement has indicated that the selection between (A)-(I), (a)-(et), and (I-XVII) are not an election of species. On the other hand, the Restriction Requirement indicates that, upon allowance of the linking claim (claim 67), the Restriction Requirement shall be withdrawn and dependent claims will be entitled to examination.

The MPEP, in section 809.03, indicates that a restriction requirement "shall be" withdrawn and dependent claims examined when the linking claim is held to be allowable.¹ And, in fact, 37 C.F.R. § 1.146 must be applied because it specifically addresses the treatment of a genus claim embracing various species. The MPEP, in §809.02, describes how to apply 37 C.F.R. § 1.146. The restriction between (A)-(I), (a)-(et), and (I-XVII) is further traversed on the grounds that there has been no prima facie case for a restriction under 37 C.F.R. §1.142.

¹ MPEP 8019.03, form 8.12 Restriction, Linking Claims Claim [1] link(s) inventions [2] and [3]. The restriction requirement [4] the linked inventions is subject to the nonallowance of the linking claim(s), claim [5]. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re Ziegler, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

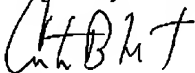
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Pursuant to MPEP 803, a restriction is not proper in the absence of such a showing.² If the restriction is to be maintained in its present form, the opportunity to rebut the reasons for the restriction is requested. It is understood that the restriction is a de facto species restriction made under 37 C.F.R. § 1.146.

The Restriction Requirement is further traversed on the grounds that some of the species do not simultaneously belong in all three categories (A)-(I), (a)-(et), and (I-XVII). For example, Groups A-I (starting on page 18 of the Restriction Requirement) are limited to those species set forth in claims 82, 84, 85, 90, 92, 108, 109 but not every member of (a)-(et) and (I-XVII) is covered by claims 82, 84, 85, 90, 92, 108, 109. The Examiner is requested to alter Group 37 to include claims 67-110, with species restrictions as needed to address concerns about searching the prior art.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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² . . . If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. . . . Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases. . . . For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That prima facie showing may be rebutted by appropriate showings or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP § 803.02. Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP § 806.04(a) - § 806.04(i) and § 808.01(a). MPEP 803. Emphases added.

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